

### **REMARKS**

Following entry of this Preliminary Amendment, this Continuation Application will contain claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34. Claims 1, 8, 18, 19, and 24 have been amended, with support for the amendments appearing at page 16, lines 20-21; page 20, lines 22-24; canceled claim 3; and Fig. 2. Claims 2, 3, 5, 6, 10, 12, 13, 16, 20, 22, and 23 were previously canceled. New claims 32-34 have been added. Consideration of the claims of this continuation application in view of the foregoing amendments and the following remarks is respectfully requested.

#### **A. Rejection Of Claims 1 and 7 Under 35 U.S.C. § 102(a)**

In the Final Office Action mailed March 24, 2003 during prosecution of the parent case (ser. no. 09/444,082), the Examiner rejected claims 1 and 7 as being anticipated by U.S. Patent 5,846,262 issued December 8, 1998 to Sayama et al. ("Sayama"). Claim 1 has been amended to incorporate the limitations of claim 3, now canceled. Specifically, claim 1 now recites that "each attachment panel consist[s] essentially of an elastomeric nonwoven material[.]"

Claim 3, which formerly depended from claim 1, was rejected by the Examiner in the Office Action mailed December 10, 2002 as being unpatentable over Sayama in view of U.S. Statutory Invention Registration H1674 published August 5, 1997 to Ames et al. ("Ames"). However, Applicants believe that the Examiner failed to give patentable weight to the exclusionary phrase "consisting essentially of." Claim 1, as presently amended to include the limitations of claim 3, requires that each attachment panel consist essentially of an elastomeric nonwoven material, each of which defines an inner attachment surface. The underlined passage is given meaning in the specification at page 3, lines 18-21: "In particular embodiments, the attachment panels consist essentially of the elastomeric nonwoven materials such that no separate fastening materials or fastening elements, loop material for example, are formed from or attached to the attachment panels." Claim 1 further requires:

at least one fastening component disposed in the second waist region on the outer surface, the at least one fastening component comprising a mechanical fastening element adapted to refastenably engage the inner attachment surfaces;

wherein the refastenable engagement of the mechanical fastening element and the inner attachment surfaces maintains the absorbent article in the pant configuration.

Sayama discloses a diaper 1 provided with front wings 11 and rear wings 12. Col. 2, lines 4-7. The diaper is provided with a hooked fastener component 15 bonded to the inner surface of each rear wing, which interlocks with a looped fastener component 16 bonded to the outer surface of the front waist region and wing 6,11. Col. 2, lines 19-42. Since each wing of Sayama has a fastener bonded thereto,

none of the wings can consist essentially of an elastomeric nonwoven material. To the contrary – Sayama's wings comprise additional fasteners. Therefore, Sayama teaches away from the invention as specified in claim 1 as amended. With respect to Ames, the Examiner has not pointed to a suggestion or motivation within Sayama to utilize the elastomeric nonwoven material disclosed in Ames. For at least the foregoing reasons, Applicants believe claim 1 as amended to be patentable over both Sayama and Ames.

Claim 7 is believed patentable over Sayama at least for depending from claim 1. Claim 7 further recites that “the first and second waist regions are not refastenably connectable other than by the refastenable connection of the mechanical fastening elements and the inner attachment surfaces.” In the Office Action mailed March 24, 2003 during prosecution of the parent case, the Examiner appears to have overlooked this limitation in her analysis of claim 7, based on her comments on page 2 (“it is noted that the features upon which applicant relies (i.e., that the first and second waist regions are connectable only by the engagement of an inner surface of the wing and fastening component) are not recited in the rejected claim(s).”) As discussed above, the front and rear regions of the diaper of Sayama are connected by interlocking the hook fasteners which are bonded to the rear wings to loop fasteners which are bonded to the front wings. As such, claim 7 cannot and does not read on the diaper of Sayama.

**B. Rejection Of Claims 4, 8, 9, 11, 14, 15, 17-19, 21, and 24-31 Under 35 U.S.C. § 103 (a)**

Claims 4, 8, 9, 11, 14, 15, 17-19, 21, and 24-31 were rejected during prosecution of the parent application (ser. no. 09/444,082) as being unpatentable over Sayama and Ames, and further in view of U.S. Patent 5,087,253 issued February 11, 1992 to Cooper with respect to claims 8, 17, 26, and 30.<sup>1</sup> Claim 8 has been amended to further recite that each fastening component has a length-to-width ratio of about 5 or greater. Claims 18, 19, and 31 have been amended to state that the attachment panels extend transversely outward from the absorbent chassis, to address the § 112 issue raised by the Examiner in the Final Office Action mailed August 13, 2001 during prosecution of the parent case. Claim 24 has been amended to correct a typographical error, whereby “first and second waist regions” has been corrected to read “front and back waist regions.”

Claim 4 depends from claim 1, but further recites that the attachment panels consist of an elastomeric nonwoven material. This phrase is given meaning in the specification, which recites at

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<sup>1</sup> Claims 4, 8, 9, 11, 14, 15, 17-19, 21, and 24-31 were rejected in the Office Action mailed September 10, 2002. Claims 4, 8, 9, 11, 15, 19, 21, and 25 were canceled in the Amendment dated December 19, 2002. The

page 3, lines 21-22, that in a particularly desirable embodiment, “the attachment panels consist of an elastomeric nonwoven without any additional materials or elements.” As stated above with respect to claim 1, Sayama teaches away from the invention as specified in claim 4. Furthermore, the Examiner has not pointed to a suggestion or motivation within Sayama to utilize the elastomeric nonwoven material disclosed in Ames.

Independent claim 9, like claim 1, recites “attachment panels consisting essentially of an elastomeric nonwoven material.” Claim 11 depends from claim 9 and further recites that the attachment panels consist of an elastomeric nonwoven material. Claims 9 and 11 are believed to be patentable over Sayama/Ames for the same reasons articulated above with respect to claims 1 and 4, respectively. In particular, the Examiner has not identified a suggestion or motivation to combine Sayama with Ames. Additionally, claims 15 and 18 are believed to be patentable at least for depending from claim 9.

Claim 14 is similar to claim 7 and recites that “the front and back waist regions are not refastenably connectable other than by the refastenable connection of the plurality of engaging elements and the inner attachment surfaces.” Neither Sayama nor Ames, nor the two in combination, discloses such a limitation. As discussed above, the front and rear regions of the diaper of Sayama are connected by interlocking hook fasteners bonded to the rear wings to loop fasteners bonded to the front wing – that is, by a means other than by connection of a plurality of engaging elements to inner attachment surfaces. Accordingly, claim 14 cannot and does not read on the diaper of Sayama. Ames discloses a diaper having multiple fastening systems adapted to connect the front and back waist regions. Col. 2, line 34 to col. 3, line 10. One fastening system allows the front and back waist regions to be connected by engaging the front waist region fastening members 80 with the rear waist closure member 78. See col. 22, lines 36-61; Fig. 4. Another fastening system allows the front and back waist regions to be connected by engaging the first closure member 82 and the second belt flap closure member 76 with the third closure member 82. See col. 22, line 62 to col. 23, line 13; Fig. 5. Accordingly, because Ames discloses a diaper having multiple means of connecting the front waist region to the back waist region, Ames cannot and does not disclose an article not refastenably connectable other than by the refastenable connection of a plurality of engaging elements to inner attachment surfaces. Indeed, both Sayama and Ames teach away from such an approach. Consequently, claim 14 is believed patentable over both Sayama and Ames, alone or in combination.

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rejections with respect to claims 14, 17, 18, 24, and 26-31 were repeated in the Office Action mailed March 24, 2003.

Claims 19, 21, 24, 25, and 31 are similar to claims 9, 11, 14, 15, and 18, respectively, and are believed to be patentable over Sayama and Ames, either alone or in combination, for the reasons stated above with respect to claims 9, 11, 14, 15, and 18. Claims 27-29 are believed patentable at least for depending from claim 19.

Dependent claims 8, 17, and 30 each further recite a pair of fastening components, each fastening component having a length-to-width ratio of at least five. Dependent claim 26 further recites refastenable seams that cover about 80 to about 98 percent of the distance between the waist opening and each leg opening. Claims 8, 17, 26, and 30 were rejected by the Examiner during prosecution of the parent application over Sayama in view of Ames and further in view of Cooper. (See Office Action mailed September 10, 2002, section 13; and Office Action mailed March 24, 2003, sections 4 and 11.) Neither Sayama nor Ames, alone or in combination, discloses each and every feature recited in claims 8, 17, 26, or 30. With respect to Cooper, the Examiner has not identified a specific motivation within any of the references to concoct a three-way Sayama-Ames-Cooper combination. Accordingly, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with respect to claims 8, 17, 26 and 30. As the Federal Circuit has repeatedly stated, it is improper to simply pick and choose elements from various prior art references to negate patentability, absent some motivation to do so:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998).

Applicants believe the Examiner has conducted an impermissible obviousness inquiry as described in In re Rouffet with respect to claims 17, 26 and 30. Specifically, the Examiner appears to

have merely pieced together elements in the prior art without pointing to a motivation or suggestion to do so within the prior art. Although the Examiner articulates what the Examiner believes to be a motivation to create a combination with Cooper (see Office Action mailed March 24, 2003, section 4), the Examiner appears to be merely reciting what she believes to be the benefits offered by the diaper of Cooper, and does not point to specific motivations to combine within any of the references.

Accordingly, Applicants respectfully request allowance of claims 4, 8, 9, 11, 14, 15, 17-19, 21, and 24-31.

**C. Canceled Claims 2, 3, 5, 6, 10, 12, 13, 16, 20, 22, and 23**

Applicants note that claims 2, 3, 5, 6, 10, 12, 13, 16, 20, 22, and 23 were canceled in the Continuation Application Transmittal Letter dated September 30, 2003.

**D. New Claims 32-34**

New claims 32-34 have been added, with support appearing in the specification at page 19, lines 31-36; page 23, lines 13-17; and Figs. 2 and 7.

**E. Formal Drawings**

Applicants direct the Examiner's attention to the enclosed set of formal drawings, which Applicants request be substituted for the drawings presently of record.

**F. Conclusion**

The application now contains claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 which are believed to be in condition for allowance in view of the foregoing amendments and remarks.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875,

The undersigned may be reached at: (920) 721-7844.

Respectfully submitted,

CHRISTOPHER P. OLSON ET AL.

By: 

H. Michael Kubicki

Registration No.: 51,235

Appl. No. 10/676,662  
Prel. Amdt. dated October 29, 2003

CERTIFICATE OF MAILING

I, Mary L. Roberts, hereby certify that on October 29, 2003 this document is being with deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Mary L. Roberts  
Mary L. Roberts